APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,850	01/29/2004	Yaniv Vakrat	5681-62301	2977

			EXAMINER
35690	7590	09/06/2006	WILSON, YOLANDA L

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
700 LAVACA, SUITE 800
AUSTIN, TX 78701

ART UNIT	PAPER NUMBER
2113	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*29 January 2004*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>*01/23/06*</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

2.   Claims 1,4-8,11-15,17-20 are rejected under 35 U.S.C. 102(e) as being

anticipated by Beardsley et al. (US Publication Number 20030131285A1). As per claim

1, Beardsley et al. discloses providing a suite of test programs on a server for execution

by a plurality of said computing devices that are coupled to said server on page 3,

paragraph 0032; on page 4, paragraphs 0042,0043; assigning a respective unique

identifier to each of said plurality of said computing devices, for use in communicating

with said server on page 3, paragraphs 0031,0032; downloading said test programs

from said server for execution by said computing devices coupled thereto, so that at

least first and second computing devices among said plurality execute different first and

second test programs from said suite substantially simultaneously on page 3, paragraph

0033; on page 4, paragraphs 0042-0044; receiving messages at said server from said

computing devices with respect to said execution of said test programs, each of said

messages containing said respective unique identifier on page 3, paragraph 0033; on

page 4, paragraphs 0042-0044; and controlling said execution of said first and second

test programs in said suite based on said messages on page 4, paragraphs 0042-0045.

The unique identifiers are the ip addresses inherently assigned to the client computers.

3.   As per claim 4, Beardsley et al. discloses wherein at least one of said test

programs comprises a bundle of tests, and wherein receiving said messages comprises

receiving requests from said computing devices to determine a next test to execute in

said bundle, and wherein controlling said execution comprises making a selection at

said server, based on said respective unique identifier contained in said requests, of

said next test to execute on each of said computing devices, and sending responses to

said computing devices indicating said selection on page 4, paragraphs 0042-0045 and

on page 3, paragraph 0033.

4.   As per claim 5, Beardsley et al. wherein said respective unique identifier of each

of said computing devices comprises an IP address on page 3, paragraph 0031. The

client computers inherently have ip addresses within a network.

5.   As per claim 6, Beardsley et al. wherein assigning said respective unique

identifier comprises receiving an initial request from each of said computing devices to

download one of said test programs, and assigning said respective unique identifier in

response to said initial request on page 4, paragraphs 0042-0044.

6.   As per claim 7, Beardsley et al. wherein said computing devices are coupled to

said server via a common test host, an identifier of said common test host being shared

by each of said computing devices in said respective unique identifier thereof on page

3, paragraphs 0031,0032.

7.   As per claim 8, Beardsley et al. accessing a suite of test programs stored therein for execution by a plurality of said computing devices that are coupled to said computer on page 3, paragraph 0032; on page 4, paragraphs 0042,0043; assigning a respective unique identifier to each of said plurality of said computing devices, for use in communicating with said computer on page 3, paragraphs 0031,0032; downloading said test programs from said computer for execution by said computing devices coupled thereto, so that at least first and second computing devices among said plurality execute different first and second test programs from said suite substantially simultaneously on page 3, paragraph 0033; on page 4, paragraphs 0042-0044; receiving messages from said computing devices with respect to said execution of said test programs, each of said messages containing said respective unique identifier on page 3, paragraph 0033; on page 4, paragraphs 0042-0044; and controlling said execution of said first and second test programs in said suite based on said messages on page 4, paragraphs 0042-0045. The unique identifiers are the ip addresses inherently assigned to the client computers.

8.   As per claim 11, Beardsley et al. discloses wherein each of at least some of said test programs comprises a bundle of tests, and wherein receiving said messages comprises receiving requests from said computing devices to determine a next test to execute in said bundle, and wherein in controlling said execution said computer is instructed to make a selection based on said respective unique identifier contained in said requests, of said next test to execute on each of said computing devices, and to

send responses to said computing devices indicating said selection on page 4,

paragraph 0042-0045 and on page 3, paragraph 0033.

9.   As per claim 12, Beardsley et al. discloses wherein said respective unique

identifier of each of said computing devices comprises an IP address on page 3,

paragraph 0031. The client computers inherently have ip addresses within a network.

10.   As per claim 13, Beardsley et al. discloses wherein assigning said respective

unique identifier comprises receiving an initial request from each of said computing

devices to download one of said test programs, and said computer is instructed to

assign said respective unique identifier in response to said initial request on page 4,

paragraphs 0042-0044.

11.   As per claim 14, Beardsley et al. discloses wherein said computing devices are

coupled to said computer via a common test host, wherein said computer is further

instructed to assign said respective unique identifier such that an identifier of said

common test host is shared by each of said computing devices in said respective

unique identifier thereof on page 3, paragraphs 0031,0032.

12.   As per claim 15, Beardsley et al. discloses a communication interface for

coupling a plurality of said computing devices thereto, such that a respective unique

identifier is assigned to each of said plurality of said computing devices for use in

communicating with said server via said communication interface in Figure 2; on page

3, paragraphs 0031-0033; and a processor adapted to provide a suite of test programs

for execution by said computing devices that are coupled to said server on page 3,

paragraph 0032; on page 4, paragraphs 0042,0043, and to download said test

programs via said communication interface for execution by said computing devices

coupled thereto, so that at least first and second computing devices among said

plurality execute different first and second test programs from said suite substantially

simultaneously on page 3, paragraph 0033; on page 4, paragraph 0042-0044, said

processor being further adapted to receive messages via said communication interface

from said computing devices with respect to execution of said test programs, said

messages containing said respective unique identifier on page 3, paragraphs

0031,0032, and to control said execution of said test programs in said suite based on

said messages and said respective unique identifier therein by communicating

responses to said messages via said communication interface, each of said responses

being addressed to a respective one of said computing devices that is associated with

said respective unique identifier on page 4, paragraphs 0042-0045. The unique

identifiers are the ip addresses assigned to the client computers.

13.   As per claim 17, Beardsley et al. discloses wherein each of at least some of said

test programs comprises a bundle of tests, and wherein said messages comprise

requests from said computing devices to determine a next test to execute in said

bundle, and wherein said server is further adapted to control said execution by making a

selection, based on said respective unique identifier contained in said requests, of said

next test to execute on each of said computing devices, and wherein said responses

indicate said selection on page 4, paragraphs 0042-0045 and on page 3, paragraph

0033.

14.   As per claim 18, Beardsley et al. discloses wherein said respective unique

identifier of each of said computing devices comprises an IP address on page 3,

paragraph 0031. The client computers inherently have ip addresses within a network.

15.   As per claim 19, Beardsley et al. discloses wherein said respective unique

identifier is assigned responsively to an initial request from each of said computing

devices to download one of said test programs on page 4, paragraph 0042-0044.

16.   As per claim 20, Beardsley et al. discloses wherein said computing devices are

coupled to said communication interface via a common test host, an identifier of said

common test host being shared by each of said computing devices, said identifier of

said common test host being included in said respective unique identifier thereof on

page 3, paragraphs 0031,0032.

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

18.   Claims 2,3,9,10,16 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Beardsley et al. in view of Topley (J2ME in a Nutshell). As per claims 2,9,

Beardsley et al. discloses wherein said computing devices comprise MIDP-compliant

devices, and wherein said test programs comprise MIDlets, which are packaged in

respective JAD files and JAR files, and wherein allocating said test programs comprises downloading said JAD files and said JAR files to said MIDP-compliant devices.

Topley discloses this limitation on page 3, under the bin heading; on page 5, under the heading 9.1.4.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have said computing devices comprise MIDP-compliant devices, and wherein said test programs comprise MIDlets, which are packaged in respective JAD files and JAR files, and wherein allocating said test programs comprises downloading said JAD files and said JAR files to said MIDP-compliant devices. A person of ordinary skill in the art would have been motivated to have said computing devices comprise MIDP-compliant devices, and wherein said test programs comprise MIDlets, which are packaged in respective JAD files and JAR files, and wherein allocating said test programs comprises downloading said JAD files and said JAR files to said MIDP-compliant devices because the MIDlets allows for testing on devices regardless of location.

19.   As per claim 3, Beardsley et al. fails to explicitly state the step of evaluating said JAD files, wherein said JAR files are downloaded responsively to said step of evaluating said JAD files.

Topley discloses this limitation on page 4, under the heading 9.1.4.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the step of evaluating said JAD files, wherein said JAR files are downloaded responsively to said step of evaluating said JAD files. A

person of ordinary skill in the art would have been motivated to have the step of
evaluating said JAD files, wherein said JAR files are downloaded responsively to said
step of evaluating said JAD files because the JAD and JAR files which make up the
MIDlets are being tested in the testing process.

20.   As per claim 9, Beardsley et al fails to explicitly state wherein said computing
devices comprise MIDP-compliant devices, and wherein said test programs comprise
MIDlets, which are packaged in respective JAD files and JAR files, and wherein
downloading said test programs comprises downloading said JAD files and said JAR
files to said MIDP-compliant devices.

Topley discloses this limitation on page 3, under the bin heading; on page 5,
under the heading 9.1.4.

Accordingly, it would have been obvious to one of ordinary skill in the art at the
time the invention was made to have wherein said computing devices comprise MIDP-
compliant devices, and wherein said test programs comprise MIDlets, which are
packaged in respective JAD files and JAR files, and wherein downloading said test
programs comprises downloading said JAD files and said JAR files to said MIDP-
compliant devices. A person of ordinary skill in the art would have been motivated to
have wherein said computing devices comprise MIDP-compliant devices, and wherein
said test programs comprise MIDlets, which are packaged in respective JAD files and
JAR files, and wherein downloading said test programs comprises downloading said
JAD files and said JAR files to said MIDP-compliant devices because the MIDlets allows
for testing on devices regardless of location.

21.   As per claim 10, Beardsley et al. fails to explicitly state wherein downloading said

test programs further comprises the steps of downloading said JAD files to said MIDP-

compliant devices, and thereafter, responsively to evaluation messages received at said

computer from said MIDP-compliant devices, downloading said JAR files to said MIDP-

compliant devices.

Topley discloses this limitation on page 4, under the heading 9.1.4.

Accordingly, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to downloading said test programs further comprises the

steps of downloading said JAD files to said MIDP-compliant devices, and thereafter,

responsively to evaluation messages received at said computer from said MIDP-

compliant devices, downloading said JAR files to said MIDP-compliant devices. A

person of ordinary skill in the art would have been motivated to have downloading said

test programs further comprises the steps of downloading said JAD files to said MIDP-

compliant devices, and thereafter, responsively to evaluation messages received at said

computer from said MIDP-compliant devices, downloading said JAR files to said MIDP-

compliant devices because the JAD and JAR files which make up the MIDlets are being

tested in the testing process.

22.   As per claim 16, Beardsley et al. wherein said computing devices comprise

MIDP-compliant devices, and wherein said test programs comprise MIDlets, which are

packaged in respective JAD and JAR files, and wherein said test programs are

downloaded as said JAD and JAR files to said MIDP-compliant devices.

Topley discloses this limitation on page 3, under the bin heading; on page 5,

under the heading 9.1.4.

Accordingly, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have wherein said computing devices comprise MIDP-

compliant devices, and wherein said test programs comprise MIDlets, which are

packaged in respective JAD and JAR files, and wherein said test programs are

downloaded as said JAD and JAR files to said MIDP-compliant devices. A person of

ordinary skill in the art would have been motivated to have wherein said computing

devices comprise MIDP-compliant devices, and wherein said test programs comprise

MIDlets, which are packaged in respective JAD and JAR files, and wherein said test

programs are downloaded as said JAD and JAR files to said MIDP-compliant devices

because the MIDlets allows for testing on devices regardless of location.

Double Patenting

23.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

24.   Claim 1,8,15 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 15,20,31 of

copending Application No. 10/767845.

This is a provisional obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claim(s) 15,20,31 of Patent/Application # 10/767845 contain(s) every element of

claim(s) 1,8,15 of the instant application and thus anticipate the claim(s) of the

instant application. Claim(s) 1,8,15 of the instant application therefore is/are not patently

distinct from the earlier patent claim(s) and as such is/are unpatentable over

obvious-type double patenting. A later patent/application claim is not patentably

distinct from an earlier claim if the later claim is anticipated by the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later

claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896,

225 USPQ at 651 (affirming a holding of obviousness-type double patenting because

the claims at issue were obvious over claims in four prior art patents); In re Berg, 140

F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-

type double patenting where a patent application claim to a genus is anticipated by a

patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR

LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON

PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the

patent. Thus, the generic invention is **"anticipated"** by the species of the patented

invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir.

1985) (holding that an earlier species disclosure in the prior art defeats any generic

claim) 4 . This court's predecessor has held that, without a terminal disclaimer, the

species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d

937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller , 397 F.2d at 354. Accordingly,

absent a terminal disclaimer, claims 12 and 13 were properly rejected under the

doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d

2010 (12/3/1993)

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Yolanda L. Wilson whose telephone number is (571)

272-3653. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Robert Beausoliel can be reached on (571) 272-3645. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yolanda L Wilson
Examiner
Art Unit 2113